

## **TABLE OF CONTENTS**

<b>I. REAL PARTY IN INTEREST .....</b>	<b>1</b>
<b>II. RELATED APPEALS AND INTERFERENCES .....</b>	<b>1</b>
<b>III. STATUS OF CLAIMS .....</b>	<b>2</b>
<b>IV. STATUS OF AMENDMENTS .....</b>	<b>2</b>
<b>V. SUMMARY OF CLAIMED SUBJECT MATTER .....</b>	<b>2</b>
<b>VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL .....</b>	<b>3</b>
<b>VII. ARGUMENT .....</b>	<b>4</b>
<b>VIII. CLAIMS APPENDIX.....</b>	<b>9</b>
<b>IX. EVIDENCE APPENDIX.....</b>	<b>10</b>
<b>X. RELATED PROCEEDINGS APPENDIX.....</b>	<b>11</b>

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of	:	Customer Number: 46320
	:	
Tsukasa TAKEMURA	:	Confirmation Number: 5681
	:	
Application No.: 10/691,006	:	Group Art Unit: 2195
	:	
Filed: October 22, 2003	:	Examiner: J. To
	:	
For: SCHEDULING METHOD, PROGRAM PRODUCT FOR USE IN SUCH METHOD, AND TASK SCHEDULING APPARATUS	:	

**APPEAL BRIEF**

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is submitted in support of the Notice of Appeal filed October 16, 2008, wherein Appellant appeals from the Examiner's rejection of claim 4.

**I. REAL PARTY IN INTEREST**

This application is assigned to IBM Corporation by assignment recorded on October 22, 2003, at Reel 014362, Frame 0116.

**II. RELATED APPEALS AND INTERFERENCES**

Appellant is unaware of any related appeals and interferences.

### **III. STATUS OF CLAIMS**

Claim 4 is pending and three-times rejected in this Application. Claims 1-3 and 5-18 have been cancelled. It is from the multiple rejections of claim 4 that this Appeal is taken.

### **IV. STATUS OF AMENDMENTS**

The claim has not been amended subsequent to the imposition of the Third and Final Office Action dated July 16, 2008 (hereinafter the Third Office Action).

### **V. SUMMARY OF CLAIMED SUBJECT MATTER**

Referring to Figure 11 and also to independent claim 4, A scheduling method for scheduling tasks providing a system designed on an object-oriented basis by using a computer is disclosed. In first step S1102, classes forming the system are extracted from design information of the system, tasks corresponding to the extracted classes are generated, and information on the generated tasks are stored into a given storage device (lines 1-6 of paragraph [0060]). In second step S1108, complexity of the classes are extracted from the design information of the system (lines 1-9 of paragraph [0054]), and workload required for implementation of the classes on the basis of the complexity are estimated, after which a result of the workload estimation is stored into the given storage device (lines 1-13 of paragraph [0053]; lines 4-5 of paragraph [0064]). In third step S1109, the tasks are scheduled on the basis of the information on the tasks stored in the given storage device and the result of the workload estimation (lines 1-6 of paragraph [0057]; lines 5-6 of paragraph [0064]). In the second step, past workload achievements in each class are used to estimate the workload of the classes (lines 5-6 of paragraph [0056]).

## **VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

1. Claim 4 was rejected under 35 U.S.C. § 102 for anticipation based upon Cohen et al., U.S. Patent No. 6,011,918 (hereinafter Cohen).

## **VII. ARGUMENT**

### **THE REJECTION OF CLAIM 4 UNDER 35 U.S.C. § 102 FOR ANTICIPATION BASED UPON**

#### **COHEN**

For convenience of the Honorable Board in addressing the rejection, claim 4 stands or falls alone.

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure, either explicitly or inherently, of each element of a claimed invention in a single reference.<sup>1</sup> Moreover, the anticipating prior art reference must describe the recited invention with sufficient clarity and detail to establish that the claimed limitations existed in the prior art and that such existence would be recognized by one having ordinary skill in the art.<sup>2</sup>

"Both anticipation under § 102 and obviousness under § 103 are two-step inquiries. The first step in both analyses is a proper construction of the claims. ... The second step in the analyses requires a comparison of the properly construed claim to the prior art."<sup>3</sup> During patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification,"<sup>4</sup> and the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach.<sup>5</sup> Therefore, the Examiner must (i) identify the individual elements of the claims and properly construe these

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<sup>1</sup> In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); Perkin-Elmer Corp. v. Computervision Corp., 732 F.2d 888, 894, 221 USPQ 669, 673 (Fed. Cir. 1984).

<sup>2</sup> See In re Spada, 911 F.2d 705, 708, 15 USPQ 1655, 1657 (Fed. Cir. 1990); Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 678, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988).

<sup>3</sup> Medichem, S.A. v. Rolabo, S.L., 353 F.3d 928, 933 (Fed. Cir. 2003) (internal citations omitted).

<sup>4</sup> In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).

<sup>5</sup> In re Cortright, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

individual elements,<sup>6</sup> and (ii) identify corresponding elements disclosed in the allegedly anticipating reference and compare these allegedly corresponding elements to the individual elements of the claims.<sup>7</sup> This burden has not been met.

Independent claim 4 recites, in part, "generating tasks corresponding to the extracted classes," and to teach this limitation, the Examiner asserted "the client applicants, and server application here referred as tasks" and cited column 4, lines 26-29 of Cohen, which for ease of reference is reproduced below:

In a further embodiment of the present invention, a client application is generated based on the objects of classes partitioned as client classes and a server application based on the objects of classes partitioned as server classes.

Not only has the Examiner failed to provide an explicit claim construction for the term "task," the Examiner's inferential analysis is misplaced. A client application is not a task. A client application is essentially a computer program to be run on a client device. Although a program/application is capable of performing a task, the program/application alone is not capable of performing the task. Instead, a computer program/application in combination with "bookkeeping information" is capable of performing the task.<sup>8</sup> Thus, Cohen fails to identically disclosed the claimed "task."

Independent claim 4 further recites, in part, "scheduling the tasks on the basis of the

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<sup>6</sup> See also, Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1567-68 (Fed. Cir. 1987) (In making a patentability determination, analysis must begin with the question, "what is the invention claimed?" since "[c]laim interpretation, . . . will normally control the remainder of the decisional process"); see Giechter v. Davidson, 116 F.3d 1454, 1460 (Fed. Cir. 1997) (requiring explicit claim construction as to any terms in dispute).

<sup>7</sup> Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

<sup>8</sup> <http://www.webopedia.com/TERM/t/task.html>.

information on the tasks stored in said given storage device and the result of the workload estimation." To teach these limitations the Examiner relied upon the abstract and column 18, lines 45-55 of Cohen. The Examiner's cited passage of column 18 refers to claims 13 and 14 of Cohen, which are reproduced below:

13. A method according to claim 12, further comprising the step of:  
distributing client objects to a client computer system in response to a request for execution of the client application.

14. A method according to claim 13, wherein said distributing step comprises the steps of:  
receiving a request for the client application and a client capability set;  
selecting a client application based on the received client capability set; and  
providing to the client the client application corresponding to the client capability set.

Entirely absent from this passage is any mention of "scheduling" tasks (i.e., allegedly disclosed by the client application and server application). Instead, this cited passage describes the unremarkable concept of distributing a client application to a client upon receiving a request accompanied by a client capability set. Appellant is unclear as to both (i) the claim construction the Examiner employed to arrive at the conclusion that this cited passage identically discloses the claimed limitations at issue and (ii) the analysis employed by the Examiner in arriving at the aforementioned conclusion. Appellant's position, therefore, is that the Examiner has further failed to establish that Cohen identically discloses all of the limitations of the claimed invention.

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Independent claim 4 further recites "extracting complexity of the classes from the design information of said system, estimating workload required for implementation of the classes on the basis of the complexity." To teach these limitations, the Examiner relied upon column 3, lines 44-51 and column 4, lines 1-8, which are reproduced below:

In particular embodiments of the present invention, the weighting of the relationships between the programmed methods is based on a textual analysis of the application written to execute on a single processing system. Alternatively, the weighting of the relationships between the programmed methods may be based on a result of a profiling analysis of the application written to execute on a single processing system. (column 3, lines 44-51)

Also, the weighting of each identified class may be accomplished by instantiating each program object of a class and determining the marginal resources utilized to instantiate each program object. A weight is then assigned to each program class based on the determined marginal resources utilized to instantiate the program objects of the class. These weights may also be adjusted by a predefined adjustment factor. (column 4, lines 1-8)

The Examiner's first cited passage describes weighting based upon "textual analysis of the application" and "a result of a profiling analysis of the application," but this passage is silent as to estimating workload (i.e., allegedly disclosed by "weighting") based upon complexity of the classes, as claimed. The Examiner's second cited passage describes that weighting involves "determining the marginal resources utilized to instantiate each program object." However, this passage is also silent as to estimating workload based upon complexity of the classes. Thus, the Examiner has further failed to establish that Cohen identically discloses all of the limitations of the claimed invention.

#### Conclusion

Based upon the foregoing, Appellant respectfully submits that the Examiner's rejection under 35 U.S.C. § 102 based upon the applied prior art is not viable. Appellant, therefore, respectfully solicits the Honorable Board to reverse the Examiner's rejections under 35 U.S.C. § 102.



Application No.: 10/691,006

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due under 37 C.F.R. §§ 1.17, 41.20, and in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: October 16, 2008

Respectfully submitted,

/Scott D. Paul/

Scott D. Paul

Registration No. 42,984

Steven M. Greenberg

Registration No. 44,725

Phone: (561) 922-3845

CUSTOMER NUMBER 46320

### **VIII. CLAIMS APPENDIX**

4. A scheduling method for scheduling tasks providing a system designed on an object-oriented basis by using a computer, comprising:

a first step of extracting classes forming said system from design information of the system, generating tasks corresponding to the extracted classes, and storing information on the generated tasks into a given storage device;

a second step of extracting complexity of the classes from the design information of said system, estimating workload required for implementation of the classes on the basis of the complexity, and storing a result of the workload estimation into the given storage device; and

a third step of scheduling the tasks on the basis of the information on the tasks stored in said given storage device and the result of the workload estimation, wherein

in said second step, past workload achievements in each class are used to estimate the workload of the classes.

**IX. EVIDENCE APPENDIX**

No evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the Examiner has been relied upon by Appellant in this Appeal, and thus no evidence is attached hereto.

**X. RELATED PROCEEDINGS APPENDIX**

Since Appellant is unaware of any related appeals and interferences, no decision rendered by a court or the Board is attached hereto.